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MAILED

JUN 20 2011

In re Application of : **OFFICE OF PETITIONS**
Filicori :
Application No. 10/559,610 : ON APPLICATION FOR
Filed: January 31, 2006 : PATENT TERM ADJUSTMENT
Attorney Docket No. 033236-0147:

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705" filed May 31, 2011, which is properly treated under 37 CFR 1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is two hundred and fifty-six (256) days, not thirty-seven (37) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

Relative to the any assertion that the Office will take in excess of 3 years of the filing date to issue this patent, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the 37 CFR 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on March 19, 2010².

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

On March 2, 2011, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment is 37 days. On May 31, 2011, applicants submitted the instant petition.

The review of the application file history reveals that the patent term was incorrectly adjusted by 64 days pursuant to 37 CFR 1.702(a)(2) and 37 CFR 1.703(a)(2) after it appeared that the Office delayed responding to a Request for Continued Examination purportedly filed March 19, 2009. In fact, applicant filed no Request for Continued Examination on March 19, 2009; this entry was made incorrectly in Office PALM records. In fact, a non-final Office action was mailed January 30, 2009, to which applicant responded on July 28, 2009, with a Notice of Appeal and amendment after final rejection. Thereafter, the Office mailed a final rejection on September 21, 2009, within four months of the filing of the Notice of Appeal and amendment after final rejection. Accordingly, the entry of 64 days of adjustment to the patent term is unwarranted and is being removed.

² It is noted that Office PALM records incorrectly indicate that a Request for Continued Examination and request for extension of time were filed on March 19, 2009. In fact, neither filing is of record in the Image File Wrapper (IFW) for the application, nor do Office accounting databases indicate that any payments for an extension of time were made on March 19, 2009. It appears that this entry was incorrectly made.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is zero (0) days (222 days of Office delay - 249 days of applicant delay).

The petition fee \$200.00 set forth in 37 CFR 1.18(e) will be charged to deposit account 19-0741.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this specific matter should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM screen



Patent
Term
Adjustments



PTA/PTE Information

Patent Term Adjustment

Patent Term Extension

Application Number*: 10559610

[Explanation of PTA Calculation](#)[Explanation of PTE Calculation](#)

PTA Calculations for Application: 10559610

Application Filing Date	01/31/2006	OverLapping Days Between (A and B) or (A and C)	0
Issue Date of Patent		Non-Overlapping USPTO Delays:	286
A Delays	286	PTO Manual Adjustment:	64
B Delays	0	Applicant Delay (APPL)	249
C Delays	0	Total PTA (days)	0

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
87	06/13/2011		P028	Adjustment of PTA Calculation by PTO	64	0	
79	03/02/2011		MN/ =.	Mail Notice of Allowance	0	0	
78	02/28/2011		IREV	Issue Revision Completed	0	0	
74	02/24/2011		ACRE	Allowed Case Returned to the Examiner for Clerical Processing	0	0	
73	02/24/2011		DVER	Document Verification	0	0	
72	02/24/2011		N/ =.	Notice of Allowance Data Verification Completed	0	0	
71	02/24/2011		DOCK	Case Docketed to Examiner in GAU	0	0	
70	02/22/2011		EX.A	Examiner's Amendment Communication	0	0	
69	02/22/2011		CNTA	Allowability Notice	0	0	
67	12/13/2010		FWDX	Date Forwarded to Examiner	0	0	
68	12/09/2010	09/09/2010	IDSC	Information Disclosure Statement considered	0	0	
66	12/09/2010	09/09/2010	A...	Response after Non-Final Action	91	61	
65	12/09/2010		XT/G	Request for Extension of Time - Granted	0	0	
64	12/09/2010		M844	Information Disclosure Statement (IDS) Filed	0	0	
63	12/09/2010		WIDS	Information Disclosure Statement (IDS) Filed	0	0	
61	06/09/2010		MCTNF	Mail Non-Final Rejection	0	0	
60	06/07/2010		CTNF	Non-Final Rejection	0	0	
55	03/30/2010		FWDX	Date Forwarded to Examiner	0	0	
53	03/30/2010		FWDX	Date Forwarded to Examiner	0	0	
51	03/30/2010		ABN9	Disposal for a RCE / CPA / R129	0	0	
59	03/19/2010		IDSC	Information Disclosure Statement considered	0	0	
57	03/19/2010		RCAP	Reference capture on IDS	0	0	
56	03/19/2010		M844	Information Disclosure Statement (IDS) Filed	0	0	
54	03/19/2010		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE	0	0	
49	03/19/2010		WIDS	Information Disclosure Statement (IDS) Filed	0	0	
48	03/19/2010		BRCE	Workflow - Request for RCE - Begin	0	0	
47	09/21/2009	07/19/2009	MCTFR	Mail Final Rejection (PTOL - 326)	64	52	
46	09/21/2009		CTFR	Final Rejection	0	0	
42	08/07/2009		FWDX	Date Forwarded to Examiner	0	0	
41	07/28/2009		AP/A	Amendment/Argument after Notice of Appeal	0	0	
40	07/28/2009		N/AP	Notice of Appeal Filed	0	0	
39	07/28/2009		XT/G	Request for Extension of Time - Granted	0	0	
52	03/19/2009		RCEX	Request for Continued Examination (RCE)	0	0	
50	03/19/2009		XT/G	Request for Extension of Time - Granted	0	0	
38	01/30/2009	01/22/2009	MCTNF	Mail Non-Final Rejection	8	30	
36	01/21/2009		CTNF	Non-Final Rejection	0	0	
43	11/26/2008	09/22/2008	M844	Information Disclosure Statement (IDS) Filed	65	30	
34	11/26/2008		IDSC	Information Disclosure Statement considered	0	0	
32	11/26/2008		WIDS	Information Disclosure Statement (IDS) Filed	0	0	
31	10/27/2008		FWDX	Date Forwarded to Examiner	0	0	
33	09/22/2008		IDSC	Information Disclosure Statement considered	0	0	
30	09/22/2008	06/21/2008	A...	Response after Non-Final Action	93	25	
29	09/22/2008		XT/G	Request for Extension of Time - Granted	0	0	
28	09/22/2008		RCAP	Reference capture on IDS	0	0	
27	09/22/2008		M844	Information Disclosure Statement (IDS) Filed	0	0	
26	09/22/2008		WIDS	Information Disclosure Statement (IDS) Filed	0	0	
25	03/21/2008		MCTNF	Mail Non-Final Rejection	0	0	
24	03/12/2008		CTNF	Non-Final Rejection	0	0	
19	01/07/2008		DOCK	Case Docketed to Examiner in GAU	0	0	
18	12/27/2007		FWDX	Date Forwarded to Examiner	0	0	
17	11/30/2007		ELC.	Response to Election / Restriction Filed	0	0	
16	10/31/2007	03/31/2007	MCTRS	Mail Restriction Requirement	214	5	
15	10/29/2007		CTRS	Restriction/Election Requirement	0	0	
14	10/24/2007		DOCK	Case Docketed to Examiner in GAU	0	0	
13	07/21/2007		DOCK	Case Docketed to Examiner in GAU	0	0	

12	07/11/2007	TSSCOMP IFW TSS Processing by Tech Center Complete	0
20	05/31/2007	IDSC Information Disclosure Statement considered	0
9	05/31/2007	RCAP Reference capture on IDS	0
8	05/31/2007	M844 Information Disclosure Statement (IDS) Filed	0
7	05/31/2007	WIDS Information Disclosure Statement (IDS) Filed	0
4	04/17/2007	OIPE Application Dispatched from OIPE	0
3	04/17/2007	M903 Notice of DO/EO Acceptance Mailed	0
5	01/31/2006	371COMP 371 Completion Date	0
0.5	06/02/2004	NEFILE International Filing date	0

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